

REMARKS

New claims 29-37 are added. The new claims are supported by the originally-filed disclosure at, for example, pages 7-9 and Fig. 7.

Claims 16-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Mandler (U.S. Patent No. 5,951,376) in view of Sorrells. Claims 21-22 and 24-28 are rejected under 35 U.S.C. §102(b) as being anticipated by Sorrells (U.S. Patent No. 4,358,913).

Regarding the obviousness rejection against independent claim 16 based on the combination of Mandler and Sorrells, claim 16 recites "the second side of the *spectacle lens is secured to a first holder by connecting material*." The Examiner relies on Mandler of the combination to teach this limitation; however, the Examiner fails to point out in Mandler a teaching to "connecting material." Moreover, Mandler fails to teach a "connecting material." In fact, Mandler cannot be appropriately modified by any other reference to include connecting material. That is, Mandler teaches chucking tools 12 and 15 to secure a lens 7 wherein applying "connecting material" would not be used on chucking tool because such would destroy the entire purpose of using chucking tools (Examiner's alleged "first holder"). That is, chucking tools are used to easily and quickly release and hold a lens to be machined without using connecting material. Accordingly, Mandler fails to teach a positively recited limitation of claim 16. Moreover, there is no reasonable modification to Mandler that would include the positively recited "connecting material," and therefore, the combination of Sorrells with Mandler fails to teach the positively recited limitation of claim 16. The Examiner is respectfully reminded that if a **proposed modification would render the prior art invention being modified unsatisfactory**

for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) (emphasis added). Pursuant to this authority, such modification of the Mandler invention is improper, and therefore, the obviousness rejection based on the combination is improper and must be withdrawn. For at least this reason, independent claim 16 is allowable.

Furthermore, respectfully, there is no reasonable rationale that can be stated to modifying the invention of Mandler with teachings of Sorrells as stated by the Examiner. The reasoning being that the invention of Mandler is specifically stated to be based on a "novel geometry of the lens blank" which would not work with the chuck and structures of Sorrells: "[t]he inventive method is thus based on a novel geometry of the lens blank...[and][t]he new shape of the lens body differs from the previous standard shapes of lens blanks...[and][t]his basic shaping of the lens body makes it possible to carry out the aspects of the invention...." (Mandler at col. 2, lines 8-20). That is, the Mandler lens must be specifically shaped (col. 2) for the Mandler invention to function, and Sorrells specifically teaches using "standard shapes of lens blanks" (Sorrells at col. 6, lines 21-25) for which Mandler specifically states its invention is not applicable. Consequently, the obviousness rejection against independent claim 16 is not appropriate based on the combination of Mandler and Sorrells and the teachings are incompatible as clearly disclosed by Mandler, and therefore, independent claim 16 is allowable for at least this reason.

Claims 17-20 and 29-30 depend from allowable independent claim 16, and therefore, the dependent claims are allowable for depending from an allowable independent claim.

For example, claim 19 is amended to recite “wherein the positioning of said first holder comprises using a collet chuck in physical contact with the first holder.” Support for the amendment language is provided by, for example, Fig. 7. The Examiner relies on Sorrells to allegedly teach a collet chuck specifically referring to structure 278. However, Sorrells teaches an intermediate structure, set block 296, between structure 278 (alleged collet chuck) and first holder 30 (Figs. 20-22). That is, structure 278 of Sorrells is not in physical contact with first holder 30 and only physically contacts seat block 296 via locking shaft 292 (Figs 20-22). Therefore, Sorrells fails to teach “a collet chuck in physical contact with the first holder” as positively recited by claim 19. Claim 19 is allowable for at least this reason.

Independent claim 21 is amended to recite “the collet chuck in physical contact with the first holder.” Support for the amendment language is provided by, for example, Fig. 7. The Examiner relies on Sorrells to allegedly teach a collet chuck specifically referring to structure 278. However, Sorrells teaches an intermediate structure, set block 296, between structure 278 (alleged collet chuck) and first holder 30 (Figs. 20-22). That is, structure 278 of Sorrells is not in physical contact with first holder 30 and only physically contacts seat block 296 via locking shaft 292 (Figs 20-22). Therefore, Sorrells fails to teach “the collet chuck in physical contact with the first holder” as positively recited by claim 21. Independent claim 21 is allowable for at least this reason.

Claims 22, 24-25 and 31-32 depend from allowable independent claim 21, and therefore, the dependent claims are allowable for depending from an allowable independent claim.

Independent claim 26 is amended to clarify that the alignment reference structure


comprises **physical material** and recites "an alignment reference structure comprising **physical material**." The Examiner relies on opening 310 of Sorrells to allegedly teach the alignment reference structure. By definition, an opening has no physical material. Accordingly, it is inconceivable that the teachings of Sorrells teach the positively recited limitation of claim 26. For at least this reason, independent claim 26 is allowable.

Claims 27-28 and 33-35 depend from allowable independent claim 26, and therefore, the dependent claims are allowable for depending from an allowable independent claim.

This application is now believed to be in immediate condition for allowance, and action to that end is respectfully requested. If the Examiner's next anticipated action is to be anything other than a Notice of Allowance, the undersigned respectfully requests a telephone interview prior to issuance of any such subsequent action.

Respectfully submitted,

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